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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,800	10/31/2003	Jorg Bernard	G5005.0027	1152
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DICKSTEIN SHAPIRO LLP			EXAMINER	
1633 Broadway			BEKKER, KELLY JO	
NEW YORK, NY 10019				
			ART UNIT	PAPER NUMBER
			1781	
			MAIL DATE	DELIVERY MODE
			10/08/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/697,800

Applicant(s)

BERNARD ET AL.

Examiner

KELLY BEKKER

Art Unit

1781

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-33, 35-50 and 61-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-33, 35-50 and 61-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendments made August 9, 2010 have been entered.
Claims 30-33, 35-50, and 61-71 are remain pending.

Claim Objections

The objection to claim 33 as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn in light of applicant's amendments made August 9, 2010.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 41 recites the limitation "protein component" in claim 38. There is insufficient antecedent basis for this limitation in the claim. Claim 38 and the claims from which claim 38 depends do not recite a "protein component".

Response to 112 Arguments

Applicant's arguments filed August 9, 2010 have been fully considered but they are not persuasive. Applicant argues that the 112 rejection of claim 41 should be withdrawn in light of applicant's amendments. Claim 41 has not been amended and the amendments to the other claims, including claim 30, does not remedy the lacking antecedent basis of claim 41. The rejection is maintained as presented above.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 30, 32, 33, 35, 38, 39, 41, 42, 44-47, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett et al. (US 6531174 B2) in view of Koji et al. (JP 40119164A as translated by the USPTO May 2008). The references and rejection are incorporated herein and as cited in the office action mailed May 10, 2010.

Regarding the newly added limitations Barrett teaches that the caramel contains gum arabic which is a polysaccharide hydrocolloid that would inherently function as a texturizing agent (Column 3 lines 17-22 and Column 4 lines 4-8); as Barrett teaches of the same compositional ingredient, gum arabic, as instantly claimed, one of ordinary skill in the art would expect that the gum arabic as taught by Barrett inherently function in the same manner as the instantly claimed ingredient, absent any clear and convincing arguments and/or evidence to the contrary.

Regarding the other amendments to claim 30 with the sweetener limitations, the limitations recited are the same as those previously presented and thus are rejection for the same reasons of record.

Claims 36, 37, 43, 48, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett et al. (US 6531174 B2) in view of Koji et al. (JP 40119164A as translated by the USPTO May 2008), further in view of Willibald-Ettle et al. (US 6458400 B1). The references and rejection are incorporated herein and as cited in the office action mailed May 10, 2010.

Claims 31, 40, 62-64, and 67-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett et al. (US 6531174 B2) in view of the combination of Koji et al. (JP 40119164A as translated by the USPTO May 2008) and Igoe et al (Dictionary of Food Ingredients 3rd Edition, page 107). The references and rejection are incorporated herein and as cited in the office action mailed May 10, 2010.

Claims 61, 65, 66, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett et al. (US 6531174 B2) in view of the combination of Koji et al. (JP 40119164A as translated by the USPTO May 2008) and Igoe (Dictionary of Food Ingredients 3rd Edition page 107), further in view of Willibald-Ettle et al. (US 6458400 B1). The references and rejection are incorporated herein and as cited in the office action mailed May 10, 2010.

Response to Arguments

Applicant's arguments filed August 9, 2010 have been fully considered but they are not persuasive.

Applicant argues that there are surprising and unexpected results because isomaltulose is not temperature stable. Applicant's argument is not convincing as the references of record teach of substantially the same product as instantly claimed and as the references of record teach of a product with isomaltulose at high temperatures and it would be expected that the products of the references would inherently be stable. Therefore, it is unclear as to what is unexpected about the temperature stability of the final product.

Applicant argues that it has been surprisingly established that the combinations of polysaccharide hydrocolloids has properties to enable the complete replacement of gelatin as texturizing agent in soft caramel while retaining special texture and consistency. Applicant's argument is not convincing as the references of record teach of substantially the same product as instantly claimed and as applicant has provided no evidence of said surprising and unexpected results from the claimed composition.

Applicant argues that no single reference teaches of the product as instantly claimed and that the combination of references is hindsight reconstruction. Applicant's argument is not convincing as (1) the rejection is a 103(a) rejection made over a combination of references and not a 102 rejection or a rejection made over a single reference; and thus the rejection represents the knowledge generally available to one of ordinary skill in the art and not the knowledge only presented by one reference; and (2) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning; But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971); and in the instant

case proper motivation and obviousness has been established in the rejection as previously presented and as incorporated herein.

Applicant argues that all of the claims do not include modified starch as a polysaccharide hydrocolloid; that Barrett requires modified starch as a texturizing agent, which is excluded from the instant claims; and that to exclude the starch of Barrett from the caramel would be to destroy the composition of Barrett. Applicant's argument is not convincing as the instant claims recite a caramel comprising certain ingredients, and thus while requiring the specific ingredients listed, including requiring a polysaccharide hydrocolloid as a texturizing agent selected from a specific group, including gum arabic and excluding modified starch, the claims as instantly recited do not exclude modified starch from the caramel composition. Thus, since the Barrett teaches that the caramel contains gum arabic which is a polysaccharide hydrocolloid that would inherently function as a texturizing agent, Barrett teaches of the instantly claimed limitation; as Barrett teaches of the same compositional ingredient, gum arabic, as instantly claimed, one of ordinary skill in the art would expect that the gum arabic as taught by Barrett inherently function in the same manner as the instantly claimed ingredient, absent any clear and convincing arguments and/or evidence to the contrary. The claims do not exclude other texturizing agents and/or modified starch from the caramel composition; and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, it is noted that the office has not presented any suggestion or motivation to exclude the modified starch of Barrett.

Applicant argues that the claims exclude the presence of sucrose which is not taught by the references. Applicant's argument is not convincing as Barrett teaches that all the sugar can be replaced with a sugar replacer (Column 4 lines 45-48) and Koji teaches that isomaltulose is preferably be the only crystalline sweetener in combination with a sugar syrup (page 6 lines 4-14). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made for caramel to be sucrose free and the only crystalline sugar to be isomaltulose since Barrett teaches that all the sugar can be replaced with a sugar replacer; Koji teaches that isomaltulose is preferably

the only crystalline sweetener in combination with a sugar syrup; and to do so would remove all of the sucrose in the caramel and maximize the benefit of the isomaltulose.

Applicant argues that there is no teaching or suggestion by Barrett of the use of isomaltulose, that all of the examples in Barrett employ a single sweetener which is either sucrose or crystalline sucrose, that Barrett does not recognize a need for a crystalline and non-crystalline sweetener phase free of gelatin, and that Koji does not teach or suggest using a non-crystalline sweetener phase which is maltitol syrup or polydextrose or hydrogenated starch hydrolysate or a combination thereof in combination with a crystalline phase which is isomaltulose together with a polysaccharide hydrocolloid to produce a gelatin free soft caramel.

Applicant's argument is not convincing as:

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986);

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applicant's argument is not convincing; and

As stated in the previous office action, Barrett teaches of forming a gelatin free soft caramel (abstract) comprising polysaccharide hydrocolloids, including gum arabic and gellan gum (Column 2 lines 16-28), and preferably a crystalline sweetener phase including crystalline sucrose in combination with sugar replacement which is selected from the group including non-crystalline sweetener phases of maltitol and/or glucose syrup which is a starch hydrolysate (Column 4 lines 39-54, Column 5 lines 30-33, and Examples 1-3); Barrett is silent to the crystalline sweetener phase as isomaltulose, wherein isomaltulose is the only

crystalline sugar in the composition; Koji teaches of a caramel composition which has improved taste, with little induction of dental caries, outstanding shapability and shape retentivity without the need for addition of sucrose, formed by incorporating palatinose, which is another name for isomaltulose (Abstract); thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute isomaltulose for all of the sucrose, i.e. the crystalline sweetener phase, in the caramel composition as taught by Barrett in view of Koji; As Barrett teaches that all the sugar can be replaced with a sugar replacers (Column 4 lines 45-48) and Koji teaches that isomaltulose is preferably the only crystalline sweetener in combination with a sugar syrup (page 6 lines 4-14), one would have been motivated to substitute isomaltulose for all of the sucrose, i.e. the non-crystalline sweetener phase, in the caramel composition in order to remove sucrose which is harmful to the dental needs of the consumer and to maximize the benefits of the isomaltulose, including the formation of an improved dental candy with improved taste and shape as taught by Koji. Thus, the product as taught by the references would comprise isomaltulose as the only crystalline sweetener in combination with a non-crystalline sugar comprising maltitol and/or glucose syrup.

Applicant argues that the contention of the office action of the gum arabic and gellan gum being in a ratio of 5-15:1 is wrong because it is calculated based on the contention of the gellan gum being 0.5-5% which relates to the ingredients listed on column 2 lines 10-23, which do not include gellan gum. Applicant's argument is not convincing. Barrett teaches that the caramel includes gum arabic with one or more additional hydrocolloids including gellan gum (claims 15, 17, and 18), wherein the gum arabic is include in the product about 0-10%, preferably about 1-8% (column 4 lines 33-35). Barrett teaches that the one or more additional ingredients are present from about 0.5-5% of the confectionary (Column 2 lines 19-22). Thus, although Barrett does not explicitly state that the gellan gum is included from about 0.5-5%, as Barrett teaches that the gellan gum is an "additional" ingredient and that "additional ingredients" are included from about 0.5-5%, the suggestion from the teachings of the reference are that

gellan gum, would be included from about 0.5-5%, and thus, the ratio of gum arabic to gellan gum would encompass a ratio of 5-15:1.

Applicant argues that the teachings of Koji exclude the use of starch syrup and wheat flour with isomaltulose and since Barrett teaches of using starch, one of ordinary skill in the art would not combine the teachings of the references. Applicant's argument is not convincing as starch syrup is a sweetener including glucose and other sugars; the reference to starch syrup and wheat flour as taught by Koji do not exclude the use of oxidized starch as taught by Barrett.

Applicant argues that as Koji teaches its composition has good properties, such as formability, shape-retention, and texture, there is no reason to use polydextrose which is a bulking and texturizing agent as taught by Igoe in order to achieve properties already present. Applicant's argument is not convincing as previously stated, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the caramel composition as taught by Barrett to include polydextrose in view of Igoe as Barrett teaches of a caramel composition which optionally comprises humectants (Column 2 lines 13-16), in which sugar can be replaced (Column 4 lines 45-48), and which includes citric acids (Column 5 lines 3-8) and Igoe teaches that polydextrose is a humectant and sugar replacer that contains citric acid. To use a conventionally known ingredient for its known and intended function would have been obvious and routine determination to one of ordinary skill in the art.

Applicant argues that Igoe does not suggest the polydextrose be present in a soft caramel base mass to prove an improved feeling while the caramel is ingested. Applicant's argument is not convincing as (1) an improved feeling on digestion is not claimed or referred to, and as (2) as Barrett teaches optional humectants and polydextrose is a humectant, the inclusion of the polydextrose in the caramel composition would have a reasonable expectation of success.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY BEKKER whose telephone number is (571)272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly Bekker/
Examiner
Art Unit 1781